

REMARKSREMARKS

Claims 1-14 are pending in this application. Claims 1-8 and 11-14 are amended herein. Support for the amendments to the claims may be found in the claims as originally filed. Reconsideration is requested based on the foregoing amendment and the following remarks.

Claim Rejections - 35 U.S.C. § 101:

Claims 1-8 and 11-14 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The rejection is traversed. Claims 1-8 and 11-14 now recite technology such as, inter alia, "implemented by a computer." Claims 1-8 and 11-14 are thus submitted be directed to statutory subject matter.

In any case, claims 1-8 and 11-14 were amended in the interest of compact prosecution only, and not for any reason of patentability. Claims 1-8 and 11-14, rather, were directed to statutory subject matter as filed originally, within the provisions of all applicable statutory and case law. In fact, according to the recent Ex parte Lundgren decision of the Board of Patent Appeals and Interferences, there is no 'technological arts' test for statutory subject matter,

"Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection cannot be sustained." Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005).

In particular, 35 U.S.C. § 101 provides,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, as provided in State Street,

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades. State Street Bank and Trust Co. v. Signature Financial Group Inc (149 F. 3d 1368, 1375 (Fed.Circ. 1998)).

Since claims 1-8 and 11-14 did produce a useful, concrete, tangible result, claims 1-8 and 11-14 were directed to statutory subject matter within the provisions of State Street.

Furthermore, as provided in State Street,

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶2.

Since claims 1-8 and 11-14 did fall within one of the four stated categories of statutory subject matter, claims 1-8 and 11-14 were directed to statutory subject matter within the provisions of State Street.

In particular, all of claims 1-8 and 11-14 recited either an apparatus or a method. Since claims 1-8 and 11-14 recited either an apparatus or a method, claims 1-8 and 11-14 fell at least within the "machine" or "process" categories of statutory subject matter provided for by 35 U.S.C. § 101.

Furthermore, as provided in State Street,

The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

Since Congress intended § 101 to extend to "anything under the sun that is made by man", claims 1-8 and 11-14 must have been directed to statutory subject matter within the provisions of State Street. Finally, as provided in State Street,

Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("We have also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)).

Since it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations, the further requirements listed at page 2 of the Office Action are unlawful and ought to have been withdrawn.

Still, as long as the Office presents these rejections, regardless of whether justified by law or not, a prudent Applicant must assess the real costs of overcoming the rejection relative to the necessarily speculative benefits to be gained by not amending the claims to suit the Office. Here, as in many cases, the real costs are perceived to outweigh the speculative benefits, and so the Office gets its way. Still, as discussed above, the Applicants are only amending claims 1-8 and 11-14 in the interest of comity, and not for any reason of patentability. Withdrawal of the

rejection is earnestly solicited.

Allowable Subject Matter:

The Applicant acknowledges with appreciation the allowance of claims 9 and 10.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-14 are allowable over the cited references. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

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02 Nov 05

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